REMARKS/ARGUMENTS

In response to the Office Action mailed October 19, 2005, the Examiner's claim rejections have been considered. Applicant respectfully traverses all rejections regarding all pending claims and earnestly solicits allowance of these claims.

Prior to addressing the Examiner's rejections, Applicant respectfully disagrees with the Examiner's interpretation of the claim term "spinning reels." Specifically, MPEP § 2111.01 states "the words of a claim must be given their plain meaning unless they are defined in the specification." Accordingly, nowhere in the specification did Applicant define the term "spinning" as "capable of spinning" as asserted by the Examiner. Also, the Examiner's argument that "spinning reels" refers to reels that were spinning in a previous play of the gaming machine is also not defined in the specification. Because the Examiner's unconventional interpretation of the term "spinning reels" is not disclosed in the specification, Applicant submits that the term "spinning" should be given its plain meaning (i.e., a reel that is rotating quickly about its own axis). However, in the interest of advancing the prosecution of this application, claims 1, 16, and 31 have been amended to clarify that the reels are currently spinning when the active subset of reels is selected.

Additionally, Applicant respectfully submits that a specific order needs to be read into the presently pending method claims because the claims impose a specific order on the performance of the method steps. Specifically, the first step in the method is "spinning a plurality of reels..." and the second step is "selecting a subset of the currently spinning reels." In order to select a subset of spinning reels, the reels must first be spinning. Accordingly, Applicant submits that the order of these steps is relevant and the claims should be read having a first step of spinning the reels followed by selecting a subset of the currently spinning reels.

Lastly, contrary to the Examiner's assertion, Applicant submits that the claimed invention is not merely a design choice under 35 USC §103. Applicant submits that there is no "design choice" standard under 35 USC §103. According to MPEP §2132, in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion the claimed invention is directed to obvious subject matter, either the references expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App.& Inter. 1985).

1. **Claim Rejections - 35 U.S.C. § 102: Claims 1, 2, 5-8, 10-12, 15-17, 20-23, 25-27, 30 and 31**

The Examiner reject ed claims 1, 2, 5-8, 10-12, 15-17, 20-23, 25-27, 30 and 31 under 35 U.S.C. § 102(e) as being anticipated by Munoz (U.S. Pub. No. 2004/024313). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims 1, 16, and 31 are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

Applicant respectfully submits that Munoz does not anticipate the presently claimed invention. Specifically, the Munoz reference does not disclose "selecting a subset of the currently spinning reels for use in determining a game outcome." In sharp contrast, the Munoz reference merely discloses a method in which the player selects the active reels and then the active reels are spun. (See, e.g., Paragraph 4 and 28). While one embodiment teaches that the deactivated (i.e., inactive or unselected reels) reels spin to a position displaying a symbol indicating the reels are deactivated, the deactivated reels are not used in determining the game

outcome. Applicant submits that there is no disclosure, teaching, or suggestion that the reels in Munoz are currently spinning during the selection of the active reels.

Additionally, Applicant respectfully submits that the Munoz reference does not disclose "consolidating the selected reels within the display window." Consolidating the active reels involves moving the remaining reels together into a closer grouping (see, specification at p. 4, line 23). In sharp contrast, Munoz does not disclose that the remaining reels are moved together. Rather, Munoz merely discloses embodiments where the unselected reels are spun to certain positions displaying an inactive reel symbol (See Fig. 3), lighting for the inactive reels are lowered or shut off with respect to the inactive reels (See ¶ 29), the inactive reels are covered (See Fig. 5-6), or the reels are "simply eliminated or replaced as illustrated in FIG. 4" (See, ¶ 30). Nowhere does Munoz teach the active reels are consolidated.

Accordingly, Applicant respectfully submits that the 35 U.S.C. § 102(e) rejection of claims 1, 2, 5-8, 10-12, 15-17, 20-23, 25-27, 30 and 31 has been traversed and respectfully requests allowance of these claims.

2. **Claim Rejections under 35 U.S.C. § 103(a): Claims 3, 4, 18 and 19**

The Examiner rejected claims 3, 4, 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Munoz (U.S. Pub. No. 2004/024313).

Applicant notes that claims 3, 4, 18 and 19 are dependent claims that depend from independent claims 1 and 16, respectively. In light of the arguments submitted in Section 1 of this response, Applicant respectfully submits that dependent claims 3, 4, 18 and 19 are not obvious in view of Munoz because this reference fails to teach or suggest "selecting a subset of the currently spinning reels" or "consolidating the selected reels within the display window" in a gaming method for playing a reel selection slot machine. Moreover, these dependent claims further recite and define the claimed invention, and thus, are independently patentable. In conclusion, Applicant respectfully submits that the 35 U.S.C. §103(a) rejection of claims 3, 4, 18 and 19 has been overcome.

3. Claim Rejections under 35 U.S.C. § 103(a): Claims 9 and 24

The Examiner rejected claims 9 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Munoz in view of the Price is Right game "Squeeze Play".

Applicant notes that claims 9 and 24 are dependent claims that depend from independent claims 1 and 16, respectively. In light of the arguments submitted in Section 1 of this response, Applicant respectfully submits that dependent claims 9 and 24 are not obvious in view of Munoz and the Price is Right game "Squeeze Play" because these references, alone or in combination, fail to teach or suggest "selecting a subset of the currently spinning reels" or "consolidating the selected reels within the display window" in a gaming method for playing a reel selection slot machine. Moreover, these dependent claims further recite and define the claimed invention, and thus, are independently patentable. In conclusion, Applicant respectfully submits that the 35 U.S.C. §103(a) rejection of claims 9 and 24 has been overcome.

4. Claim Rejections under 35 U.S.C. § 103(a): Claims 13, 14, 28 and 29

The Examiner rejected claims 13, 14, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Munoz in view of Fier (U.S. Pat. No. 6,126,542).

Applicant notes that claims 13, 14, 28 and 29 are dependent claims that depend from independent claims 1 and 16, respectively. In light of the arguments submitted in Section 1 of this response, Applicant respectfully submits that dependent claims 13, 14, 28 and 29 are not obvious in view of Munoz and Fier because these references, alone or in combination, fail to teach or suggest "selecting a subset of the currently spinning reels" or "consolidating the selected reels within the display window" in a gaming method for playing a reel selection slot machine. Moreover, these dependent claims further recite and define the claimed invention, and thus, are independently patentable. In conclusion, Applicant respectfully submits that the 35 U.S.C. §103(a) rejection of claims 13, 14, 28 and 29 has been overcome.

CONCLUSION

Applicant has made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 1-31 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8300. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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